

## REMARKS

Claims 1 - 31 are pending. In the Office Action mailed January 21, 2004 (Paper No. 6), claim 1 – 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,046 granted to Scott et al. (hereinafter “*Scott*”), and further in view of U.S. Patent 6,137,671 granted to Staffiere (hereinafter “*Staffiere*”). These rejections are respectfully traversed.

*Scott* in view of *Staffiere* fails to provide a prima facie basis for the rejection of claims 1-31, because it fails to disclose each element of the claimed invention. For example, claim 1 includes a “**high voltage** isolation barrier structure, comprising: a circuit board comprising a substrate, the substrate comprising a first side and a second side; a capacitive structure comprising: a first electrode disposed on the first side of the substrate; and a second electrode disposed on the second side of the substrate; and wherein the substrate intermediate the first and second electrodes functions as a dielectric material within the capacitive structure.” In contrast, *Staffiere* discloses a low-voltage capacitor that has been optimized for energy storage. It is noted that the term “high voltage” does not appear anywhere in *Staffiere*. For example, Fig. 14 of *Staffiere* shows a +5 volt and -5 volt potential applied to the energy storage device – since one way to increase the energy storage of a capacitor is to operate it at a higher voltage, due to the relationship  $W = \frac{1}{2} * C * V^2$ , where W equals the stored energy, C equals the capacitance, and V equals the voltage difference, it would not be obvious to one seeking to implement the isolation barrier of *Scott* to use the low voltage energy storage device of *Staffiere*, which has been optimized to store energy at low voltages. In fact, *Scott* teaches away from the combination with *Staffiere*, as it states at col. 6, line 56 to col. 7, line 20 that the intended application for the isolation barrier 120 is to isolate 110-volt alternating current circuits from low voltage, battery-fed direct current circuits. One of ordinary skill in the art would no doubt rely on smaller, inexpensive, pre-existing high-voltage capacitors which are the admitted prior art of *Scott* (col. 2, lines 24-26), and would not be motivated to try and modify the low voltage energy storage device of *Staffiere* for such an application. The only motivation for such a modification and the combination is the impermissible use of the disclosure of the present application as a roadmap.

Similar arguments likewise apply to the improper combination of *Scott* and *Staffiere* to reject claims 8, 19, and 29, which are believed to be novel and non-obvious for the reasons discussed above. Dependent claims 2 through 7, 9 through 18, 20 through 28, and 30 through 31

depend from independent claims 1, 8, 19 and 29, respectively, and are allowable at least for the reasons that they each depend from an allowable base claim and add additional limitations not found in the prior art. Withdrawal of the rejection of claims 1-31 is respectfully requested.

In addition, assuming, *arguendo*, that *Scott* in view of *Staffiere* does provide a prima facie basis for the rejection of claims 1-31, which is not conceded by Applicants, the enclosed Declaration of inventors Beutler and Rahamim establishes that the invention predates the filing date of *Staffiere*. As such, the Applicants are also able to overcome the rejection under 35 U.S.C. 103 by showing prior invention. Nevertheless, it is believed that the basis for withdrawing the rejection of claims 1-31 under 35 U.S.C. 103 over *Scott* in view of *Staffiere* is for the reasons discussed above in regards to the failure of *Scott* to provide any motivation for using other than pre-existing, inexpensive high voltage capacitors, and the failure of *Staffiere* to disclose a high voltage isolation barrier and the fact that it discloses, instead, a low voltage energy storage device.

### CONCLUSION

In view of the foregoing remarks and for various other reasons readily apparent, Applicants submit that all of the claims now present are allowable, and withdrawal of the rejections and a Notice of Allowance are courteously solicited.

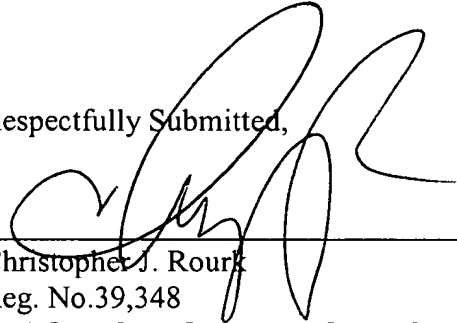
If any impediment to the allowance of the claims remains after consideration of this response, a telephone interview with the Examiner is requested so that such issues may be resolved as expeditiously as possible.

No additional fees are believed to be due. If any other applicable fee or refund has been overlooked, the Commissioner is hereby authorized to charge any fee or credit any refund to the deposit account of Akin, Gump, Strauss, Hauer & Feld, L.L.P., No. 01-0657.

Date: \_\_\_\_\_

4/16/04

Respectfully Submitted,



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